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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,799	12/28/2000	Albert Y. Teng	42390P10833	9363

8791 7590 01/12/2005

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EXAMINER

MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/752,799

Applicant(s)

TENG ET AL.

Examiner

DIANE D. MIZRAHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DIANE D. MIZRAHI  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**III. DETAILED ACTION**

Claims 1-15 are presented for examination.

In response to Applicant's communication filed on August 13, 2004, regarding Claims 1-15 are presented for examination.

Amended Abstract submitted with Amendment of August 13, 2004 has been received and entered in Applicant's specification.

Applicant's statement regarding Table 1 and 2 which are non-compliant with 37 CFR sections 1.52(a) and (b), Examiner withdraws the disclosure objection of Schemes of Tables 1 and 2. Applicant's arguments submitted on August 13, 2004 with respect to claims 1-15 have been reconsidered but are not deemed persuasive for the reasons set forth below.

**Response to Applicant' Remarks**

Examiner has completed a through study of Applicant's amendment of August 13, 2004. Especially, Applicant's amendments to claims 1-15 and remarks at pages 6-13 of the Amendment of August 13, 2004 has been carefully studied and reviewed.

Applicant's amendments to 1-15 further direct the claimed invention an apparatus, method, and an article of content categories.

Examiner asserts that Mann et al. (U.S. Patent No. 6,298,341 B1 and Mann hereinafter) in combination with Belfiore

et al. (U.S. Patent No. 6,009,459 and Belfiore hereinafter) teaches Applicant's claimed invention of apparatus, method, and an article of content categories. In addition, the specially discussed feature of the claimed invention ("storing a plurality of content categories") is very clearly discussed in Mann (Figure 5A elements 504,; Figure 1, element# 114,106) see also (Figure 5A, above element 504, i.e. money, acme, international, business, flower(s), rental(s)...) in which according to Applicant, "content categories are broad classifications of content, for example, sports, weather, finance, etc." (specification, page 7, lines 19-20).

The feature of the claimed invention "having at least one content category of the plurality of content categories" is very clearly discussed in Mann (i.e. tax which is chosen from a plurality of contents such as money, acme, business shown in Figure 5A elements 504). Mann clearly teaches Applicant's content categories and having a least one content category of the plurality of content categories as described above.

Examiner disagrees with Applicant regarding the claimed, "plurality of search engines". According to Mann's Figure 5A, Microsoft Internet Explorer (TM) under the address portion using the Internet address <http://www.whoisplus....>, a user can search any search engine such as whoisplus, or google or msn or

yahoo or any other search engine that is accessible by the Internet; see also Mann (col 6, lines 36-37). This is clearly known to "one of ordinary skill in the art". Belfiore clearly expresses the "plurality of search engines" which again is suited for searching web sites related to the entered context... the determined search engine will attempt to locate and return information... from a least one web site that closely relates ... the entered text (Belfiore, col 2, lines 22-27) see also, many search engines (Belfiore, col 6, line 2) or multiple search engines (Belfiore, col 6, lines 42). Examiner asserts that Mann in combination with Belfiore's plurality of search engines teaches Applicant's invention with the motivation to automatically retrieve information regarding appropriate web site) (Belfiore, col 4, lines 35-40).

Examiner respectfully thanks Applicant for pointed out MPEP 2141.01(a) which Examiner is well aware that "to rely on a reference under 35 USC 103, it must be analogous prior art"... (In re Oetiker, 977 F.2d 1443 (Fed.Cir.1992)). Again, Mann in combination with Belfiore teaches Applicant's invention and "... content categories ... a plurality of search engines ... having at least one content category of a plurality of the plurality of content categories" is clearly stated in the prior art made of record and also is well know to "one of ordinary skilled in the

art". Therefore, Mann and Belfiore establishes *prima facie* case of obviousness and establishes reason to combine the teachings of the references (emphasis added) (MPEP 2143.01 (Ex parte Levengood, 28 USPQ2d 1300 (Bd.Pat. App. & Inter. 1993)).

In conclusion, Examiner respectfully maintains that prima facie case of obviousness under 35 U.S.C. 103 has been established for reasons set forth in the first office action (incorporated within and noted below) and for reasons set forth in this office action.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al. (U.S. Patent# 6,298,341 B1 and Mann hereinafter) in view of Monahan et al. (U.S. Patent#

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6,523,037 B1 and Monahan hereinafter).

Regarding Claims 1, 6, and 11, Mann teaches the claimed, "storing a plurality of content categories" (i.e. data store 110 for storing adjunct terms and, possibly, available domain name lists, InterNIC) (col 3, lines 50-55); and identifying (i.e. users may access a domain name service and system and receive lists of available candidate domain names) (col 3, lines 40-55) according to properties returned by (i.e. the Internet) (col 3, lines 40-55), at least one search engine (i.e. via the internet ... WWW browser; see also Figure 5A search button) (col 4, lines 27-29) suited to service a query (i.e. user may enter search terms) (col 7, lines 1-22) Figure 5A, #507) having at least one content category of the plurality of content categories (Figure 5A, #507; see also col 7, line 1-22).

Mann does not expressly teach the claimed, "a plurality of search engines".

Monahan teaches the claimed, "a plurality of search engines" (i.e. Alta Vista, Google...) (col 1, lines 14-26).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Mann with the teachings of Monahan to include a plurality of search engines with the motivation to allow a user

to a particular web site that may be of interest (Monahan, col 1, lines 26-33).

Regarding Claims 2, 7, and 12, Mann teaches the claimed, "identifying at least one domain of the at least one search engine suited to service the query" (i.e. domain names consist of a root name or cipher followed by a period (pronounced "dot") which is then followed by what has been referred to as a "top level domain" indicator (e.g., ".com", ".org", ".gov", ".net", ".cc", and other domains such as country codes, etc. (col 1, lines 14-33).

Regarding Claims 3, 8 and 13, Mann teaches the claimed, "analyzing the content of a query to determine the at least one content category of the query" (col 3, lines 50-55) "and identifying at least one domain of the at least one search engine suited to service the query according to the content category" (col 7, lines 1-22) Figure 5A, #507).

Regarding Claims 4, 9, and 14, Mann teaches the claimed, "identifying the at least one domain according to a scope of the query" (i.e. moneytax.com) (col 4, lines 29-39):

Regarding Claims 5, 10 and 15, Mann teaches the claimed, "child categories" (i.e. domain names in accordance with user-specified criteria such as user-specified root terms

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or names which are automatically concatenated, in particular the root specifies a parent within the hierarchy in which the sub root is the child) (col 4, lines 10-18).

Therefore, Examiner will not withdraw the rejection of claims 1-15 because the argument has been fully considered but is not found to be persuasive.

As noted above, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of "ordinary skill in the art". See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both cited references teach inventions that are in the same field of endeavor. The primary reference, Mann et al. teaches the claimed, "content categories", in which he teaches a major part of the current invention, as discussed above, and the secondary reference, Belfiore et al. teaches the claimed, "plurality of search engines" see Examiner's Office Action, dated July 7, 2004. The Examiner asserts and maintains that it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of

the two inventions to reach the desired functionality of the Applicant's invention as claimed by Applicant's filed claims.

Examiner has reconsidered Applicant's remarks and maintains the rejection of claims 1-15 as set forth above.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Other Prior Art Made of Record**

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents

and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Diane D. Mizrahi  
Primary Patent Examiner  
Technology Center 2100

December 22, 2004